

**REMARKS****Response to Claim Objections**

Claim 1 is objected to by the Examiner because of the following informalities: At line 19, the limitations "the patient's body" should apparently read -- a patient's body --. Applicants have amended the above claim to address these informalities.

**Response to Drawing Objections**

In the Office Action Summary the Examiner had checked the box indicating an objection to the drawings. However, no reference was made in the Detailed Action to objections to the drawings. Applicants question whether the box was inadvertently checked. If not, Applicants request that the Examiner clearly indicate the objections to the drawings that the Examiner refers to.

**Response to Claim Rejections Under 35 U.S.C. §103**

Claims 1, 20, 31-32, and 40-51 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis (U.S. Pat. No. 5,794,626) in view of Tihon et al. (U.S. Pat. No. 5,415,656). In this rejection the Examiner contends that Kieturakis teaches an encapsulation of the separated tissue. Applicants disagree with the Examiner's contention. While Applicants appreciate that the Examiner must broadly interpret prior art references, the Examiner may not expand the teachings of a reference beyond the scope of the prior art's disclosure. Specifically, Kieturakis discloses tissue removal from the site, but the reference does not disclose using the cutting elements 15 for encapsulation. Applicants assume that the Examiner has concluded that cutting elements 15 of Kieturakis may be used for encapsulation even though there is no suggestion of using the cutting elements 15 for encapsulation. Tissue removal in the

Kieturakis is effected by delivery of fluid to the site to mix with cut tissue and aspiration of the fluid and tissue mixture by applying a vacuum to the site.

Applicants submit that the Examiner's contention that the cutters 15 of the Kieturakis device may be employed for encapsulation is unfounded supposition on the part of the Examiner. If tissue is removed according to the Kieturakis teaching by aspirating the mixture of fluid and tissue from the site, there would be no need for encapsulation of tissue and there would clearly be no suggestion of encapsulation by the cutters 15.

To further clarify this issue, Applicants have amended the independent claims to require that the encapsulation component to encapsulate the intact specimen and secure the intact specimen to the distal shaft portion to facilitate removal of the specimen upon removal of the device, assembly or instrument.

Tihon et al. is relied upon by the Examiner for the teaching of electrosurgical cutting. However, Tihon et al. do not teach severing a tissue specimen from supporting tissue. The device of Tihon et al. makes a linear cut through the patient's prostate to enlarge the urethral passage. Tissue is not removed by the Tihon et al. device. Importantly, Tihon et al. fails to make up for the deficiencies of Kieturakis with respect to encapsulation. Tihon et al. does not sever tissue so there would be no encapsulation.

The Applicants submit that the cited prior art fails to teach all of the features of Applicants' claims, and further, that there is no suggestion for combining these references.

## Conclusion

Applicants believe that the pending claims define patentable subject matter.

Reconsideration and an early allowance are respectfully requested.

Respectfully submitted,

By:   
Edward J. Lynch  
Registration No. 24,422  
Attorney for Applicants

DUANE MORRIS LLP  
One Market  
Spear Tower, Suite 2000  
San Francisco, CA 94105  
Telephone: (415) 957-3000  
Facsimile: (415) 957-3001  
Direct Dial: (415) 957-3067